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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/594,726

09/29/2006

Yoshihiko Nakashima

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CLARK & BRODY

1090 VERMONT AVENUE, NW

SUITE 250

WASHINGTON, DC 20005

EXAMINER

AZIZ, KEITH T

ART UNIT

PAPER NUMBER

1791

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/594,726	Applicant(s) NAKASHIMA ET AL.	
	Examiner KEITH T. AZIZ	Art Unit 1791	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-75 is/are pending in the application.
- 4a) Of the above claim(s) 1-58 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 59,62,63 and 65-67 is/are rejected.
- 7) ☒ Claim(s) 60,61,64 and 68-75 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 September 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>9/29/2006</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of claims 59-75 in the reply filed on 6/1/2009 is acknowledged.
2. Claims 1-58 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 6/1/2009.

Claim Rejections - 35 USC § 102/103

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 59 is rejected under 35 U.S.C. 102(b) as anticipated by Japanese Patent Application 2000-315966, of which U.S. Patent Application 2004/0194893 (Shirakura hereafter) is being used as an English translation..

Shirakura discloses an apparatus and method for producing print with a recording medium (see title and Abstract). Shirakura teaches that a laminate material is thermally press bonded to a recording medium (see paragraph [0137], as well as Figures 7A-7C). Shirakura further teaches that the laminate is larger than the recording medium (see Figure 7C), as laminate is large enough to be folded over the recording medium. Shirakura further teaches that the laminate, which protrudes out past the recording medium due to the larger size of the laminate, is disposed on the side surface

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of the recording medium that is opposite of the recording surface (again, see Figures 7A-7C). Shirakura further teaches that a transfer means sandwiches the laminate layer, which prior to sandwiching protrudes outward from the recording medium, and disposes the layer on both the recording surface and the opposite surface (see paragraph [0029] and Figure 7C).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

7. Claims 63, and 65-66 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shirakura as applied to claim 59 above, and further in view of Japanese Patent Publication 10-202744 (Toru hereafter) .

Shirakura teaches the process of claim 59 as discussed above.

Shirakura does not explicitly state that plural thermal press bonding steps occur.

Toru teaches that there are two sets of pressure rollers that apply pressure to a heated laminate (see items 12, 13, and 18 in Figure 1, as well as the Abstract). It would have been obvious to one of ordinary skill in the art at the time the invention was made to include the thermal press bonding of Toru in the process of Shirakura. The rationale to do so would have been the motivation to control the temperature in a manner that would produce favorable adhesion of the laminate to the recording medium.

With regards to claim 65, Sakura teaches the process of claim 59 as discussed above.

Sakura further teaches that several recording media may be successively supplied, and that the recording media are spaced a given distance from subsequent recording media (see Figure 7A).

Shirakura does not explicitly state that a thermal press bonding step occurs.

Toru teaches that there are two sets of pressure rollers that apply pressure to a heated laminate (see items 12, 13, and 18 in Figure 1, as well as the Abstract). It would have been obvious to one of ordinary skill in the art at the time the invention was made to include the thermal press bonding of Toru in the process of Shirakura. The rationale to do so would have been the motivation to control the temperature in a manner that would produce favorable adhesion of the laminate to the recording medium.

With regards to claim 66, Sakura teaches the process of claim 59 as discussed above. Sakura further teaches that the laminate material may have a length that is longer than the length of the recording medium in two directions, with one being orthogonal to the other (see Figure 7D).

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Shirakura does not explicitly state that a thermal press bonding step occurs.

Toru teaches that there are two sets of pressure rollers that apply pressure to a heated laminate (see items 12, 13, and 18 in Figure 1, as well as the Abstract). It would have been obvious to one of ordinary skill in the art at the time the invention was made to include the thermal press bonding of Toru in the process of Shirakura. The rationale to do so would have been the motivation to control the temperature in a manner that would produce favorable adhesion of the laminate to the recording medium.

8. Claims 62, and 67 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shirakura as applied to claim 59, further in view of U.S. Patent 6,176,286 (Kitagawa hereafter).

Shirakura teaches the process of claim 59, as discussed above.

Shirakura does not explicitly state the transfer width of the laminate layer.

Kitagawa discloses a film applying apparatus (see title and Abstract). Kitagawa teaches that the width of materials being laminated may become as large as 800 mm (see lines 31-35 of column 2). It would have been obvious to one of ordinary skill in the art at the time the invention was made to include the width of the laminate as taught by Kitagawa in the process of Shirakura. The rationale to do so would have been the common sense reasoning to adjust the width of the laminate to accommodate larger substrates to be covered by the same process.

With regards to claim 67, Shirakura teaches the process of claim 59, as discussed above.

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Shirakura does not explicitly disclose that the length of the laminate is substantially equal to the length of the substrate to which it is applied.

Kitagawa teaches that the length of the laminate is substantially equal to the length of the substrate to which it is applied (see lines 46-51 of column 1). It would have been obvious to one of ordinary skill in the art at the time the invention was made to include the dimensions of the laminate film taught by Kitagawa in the process of Shirakura. The rationale to do so would have been the common sense reasoning that a more fitted laminate film is less wasteful, and therefore more cost effective.

Allowable Subject Matter

9. Claims 60-61, 64, and 68-75 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Specifically, the limitation describing the manner in which cutting is detailed in claim 60, where the laminate is adhered to the transfer means and the recording medium and cut while being adhered to two separate surfaces and folded would be allowable if combined with the limitations of claim 59.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The following documents are cited to show the state of the art with respect to laminating processes and the cutting that occurs during lamination processes.

U.S. Patent Application 2002/0170939 to Onodera et al., drawn to a method for producing a metal laminate

U.S. Patent 6,136,142 to Kitagawa et al., drawn to a film applying apparatus.

U.S. Patent Application 2001/0004001 to Kano, drawn to a linear bonding process and apparatus.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KEITH T. AZIZ whose telephone number is (571)270-7658. The examiner can normally be reached on Monday through Thursday 8:00am-6:30pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Katarzyna Wyrozebski can be reached on (571) 272-1127. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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/KHANH NGUYEN/
Primary Examiner, Art Unit 1791